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Howard Sidman
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Vienna VA 22180

MAILED
SEP 14 2012
OFFICE OF PETITIONS

In re Patent No. 6,078,179 :
Issue Date: June 20, 2000 :
Application No. 08/840,069 : DECISION ON PETITION
Filed: April 24, 1997 :
Title: SELECTIVE POLARIZATION :
MATCHING FILTER FOR TRIGGERING AND :
MAXIMIZING RAPID DIELECTROKINESIS :
RESPONSE :

This is in response to the petition under 1.378(b), filed August 6, 2012, to accept the unavoidably delayed payment of the maintenance fee in an expired patent.

The patent issued on June 20, 2000. The third maintenance fee could have been paid during the period from June 20, 2011 through December 20, 2011, or with a surcharge during the period from December 21, 2011 through June 20, 2012. Accordingly, this patent expired on June 21, 2012, for failure to timely remit the third maintenance fee.

The Office reminds petitioner that a grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed

promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The Office further reminds petitioner that pursuant to 37 CFR 1.378(d), a petition under 37 CFR 1.378 must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

In this instance, Howard Sidman signed the present petition; however, there is no indication in the USPTO's records that Mr. Sidman is an attorney or agent registered to practice before the USPTO. Moreover, Mr. Sidman has not shown that he has authority to sign on behalf of an assignee. Specifically, neither the present petition nor the patent file include a Statement under 37 CFR 3.73(b) authorizing Mr. Sidman to act on behalf of an assignee.¹ The Office will not presume from the filing of the present petition that Mr. Sidman is a proper party pursuant to 37 CFR 1.378(d). See

¹ Pursuant to 37 CFR 3.73:

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

- (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment)...For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or
- (ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

- (i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or
- (ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

generally MPEP 324 and 37 CFR 3.73(b). It is concluded that the petition is improperly signed, and therefore, will not be treated on the merits. Accordingly, the petition is dismissed. In order for Mr. Sidman to take action in this matter, Mr. Sidman must submit a completed Statement Under 37 CFR 3.73(b) form with any "renewed" petition under 37 CFR 1.378. The appropriate form is enclosed for petitioner's convenience.

Although the Office will not address the petition on its merits at this time, the Office reminds petitioner that in determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). At the time of the expiration of a patent, it is the patent owners who are ultimately the persons responsible to ensure the timely payment of the maintenance fees. The patent owners may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owners from their obligation to take appropriate steps to ensure the timely payment of such maintenance fees.

To establish a showing of "unavoidable" delay based upon medical incapacitation, a petitioner must demonstrate that a patentee's incapacitation was of such a nature and degree as to render the patentee unable to conduct business (e.g., correspond with the Office) during the period when the maintenance fee was due. Such a showing must be supported by a statement(s) from patentee's treating physician(s), and such statement(s) must provide the nature and degree of the patentee's incapacitation during the period from when the maintenance was due until the filing of a grantable petition under 37 CFR 1.378.

In the alternative, petitioner may wish to file a petition under 37 CFR 1.378(c) based on UNINTENTIONAL DELAY. Petitions under 37 CFR 1.378(c) are less burdensome (requiring a statement of unintentional delay rather than a showing accompanied by documentary evidence). If petitioner decides to file a petition under 37 CFR 1.378(c) based on UNINTENTIONAL DELAY instead of a petition under 37 CFR 1.378(b) based on UNAVOIDABLE DELAY, petitioner should submit the enclosed "Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c))" (PTO/SB/66).

A petition under 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (i.e., the expiration date of the patent) and be accompanied by (1) a verified statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3)

payment of the \$1,640.00 surcharge **(the \$700.00 surcharge previously paid may be credited thereto leaving a balance due of \$940.00)** set forth in 37 CFR 1.20(i)(2).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
 ATTN: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Correspondence may also be submitted electronically via the USPTO electronic filing system.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Form PTO/SB/66 and Form PTO/SB/96